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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/535,723	05/20/2005	Manuel Vangelisti	P/3610-59	9221

2352 7590 03/06/2007  
OSTROLENK FABER GERB & SOFFEN  
1180 AVENUE OF THE AMERICAS  
NEW YORK, NY 100368403

EXAMINER
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ROBINSON, BINTA M

ART UNIT	PAPER NUMBER
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1625

SHORTENED STATUTORY PERIOD OF RESPONSE	MAIL DATE	DELIVERY MODE
3 MONTHS	03/06/2007	PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

**Office Action Summary**

Application No.

10/535,723

Applicant(s)

VANGELISTI, MANUEL

Examiner

Binta M. Robinson

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 2-13 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 2-13 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
  3. ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)          | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. ____.                                      |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)          | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date ____.  | 6) <input type="checkbox"/> Other: ____.                          |

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### Detailed Action

The objection to claim 1, the 112, first paragraph enablement rejection of claims 1-12, the 103 (a) rejection of claims 1, 2, 8, 9, and 10 over JP 10-101646 and the 102 (a) rejection over Dan et. al. are removed in light of applicant's amendment filed 9/25/06.

(modified rejection)

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 2- 13 is rejected under 35 U.S.C. 103(a) as being unpatentable over Dann et. al. (See Reference O) in view of Rylander and Frebault A. (Hcaplus 1906:119496). *either on 1* *TCL*

Dann et. al. (WO0216322) teaches the process of preparing aminomethylpyridines of the compound of formula I which is performed at 0 to 60 degrees Celsius using a Palladium catalyst. At claim 12, page 13, see the Dann process. The difference between the prior art process and the instantly claimed process is the teaching of the process of preparing aminomethylpyridines of the compound of formula I using a palladium catalyst which is performed at a temperature from 0 to 60 degrees Celsius versus the instant process of preparing aminomethylpyridines which occurs at the range of the Temperature of from

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30 to 70 degrees Celsius, under a hydrogen pressure of from 1 to 50 bar which the instant process occurs at- the instant process also uses a Raney Nickel catalyst rather than a palladium one. Rylander teaches that Nickel is one of the best catalysts for converting low molecular weight aliphatic nitriles to primary amines. See page 140 of Rylander. Frebault states that that corresponding hydrocarbons were obtained from the hydrogenation of aromatic nitriles in the presence of reduced nickel at 200 degrees, and that the reaction is similar to that which takes place with the aliphatic nitriles. It would have been obvious to one of ordinary skill in the art perform this process of preparing aminomethylpyridines of the compound of formula I which is performed at temperature from 30 to 50 degrees Celsius and under a hydrogen pressure of from 1 to 50 bar, which is a range inside of the prior art Temperature range at which the prior art process occurs, using a Raney Nickel Catalyst. One of ordinary skill in the art would have recognized the suitability of adjusting the prior art ranges to reach the claimed ranges. See *In re Harris*.

Accordingly, the instant process is deemed unpatentable therefrom in the absence of a showing of unexpected results for the claimed process over those of the prior art process.

(Old rejection)

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

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Claims 11-12 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

A. Claims 11-12 contain the trademark/tradename Raney nickel. Where a trademark or trade name is used in a claim as a limitation to identify or describe particular material or product, the claim does not comply with the requirements of 35 U. S. C. 112, second paragraph. See *Ex parte Simpson*, 218 USPQ 1020 (Bd. App. 1982). The claim scope is uncertain since the trademark or trade name cannot be used properly to identify any particular material or product. A trademark or trade name is used to identify the source of goods, and not the goods themselves. Thus a trademark or trade name does not identify or describe the goods associated with the trademark or trade name. In the present case, the trademark/trade name is used to identify/describe a nickel catalyst, however, it is not clear which nickel catalyst is described, since "Raney Nickel" can describe several nickel catalysts, and accordingly, the identification/description is indefinite.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Binta M. Robinson whose telephone number is (571) 272-0692. The examiner can normally be reached on M-F (9:30-6:00).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Dr. Thomas McKenzie can be reached on 571-272-0670.

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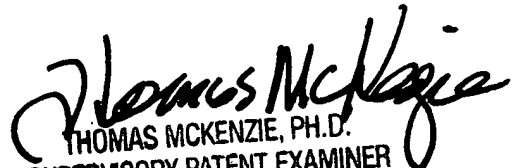
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A facsimile center has been established. The hours of operation are Monday through Friday, 8:45 AM to 4:45 PM. The telecopier numbers for accessing the facsimile machine are (703)308-4242, (703)305-3592, and (703)305-3014.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (571)-272-1600.

BMR  
February 26, 2007

  
THOMAS MCKENZIE, PH.D.  
SUPERVISORY PATENT EXAMINER  
TECHNOLOGY CENTER 1600